REMARKS

Applicants' representatives thank the Examiner for the courtesy of an in-person interview on October 8, 2003. This amendment addresses substantive points discusses during interview. The Applicants are not aware of any substantive points discussed that are not contained within this amendment. Accordingly, this amendment constitutes a complete written statement of the reasons presented in the interview as warranting favorable action, as required by 37 C.F.R. §1.33.

Claims 1-50 and 64-82 have been cancelled without prejudice. Applicants reserve the right to pursue claims similar or identical to the subject matter of claims 1-50 and 64-82 in one or more continuation applications claiming priority to the instant application.

Claim 56 has been amended to recite "comprises" instead of "includes." Claims 54, 55, and 60-62 have been amended to recite "comprising" instead of "involving." These amendments are made solely for reasons of clarity, and do not alter the scope of the claims in any way, as all of these transitional phrases are understood to be open-ended, i.e., to mean including but not limited to.

Claim 51 has been amended to clarify that the dimension is the dimension on the surface of the article. Claim 51 has also been amended to recite that the at least one channel of the mask defines a second portion of the surface. These amendments is supported by the specification, for example, on page 9, lines 29 to page 10, line 2.

Claim 52 has been amended to recite a "curved" surface. Support for this amendment can be found throughout this specification, and as one example, on page 15, lines 27-28.

Claim 53 has been amended to recite "a dimension of less than 1 millimeter." Support for this amendment can be found throughout the specification, for example, on page 10, lines 17-19.

No new matter has been added. Claims 51-63 are now pending for examination. Claim 63 remains withdrawn.

Claim Objections

Claims 2-33, 36, 38, 41, 42, 45, 50, 54-62, 64, 65, and 84-90 were objected to in the Office Action. The Office Action states that "'A' should be replaced by 'The' for proper reference to the claim on which it depends."

Applicants are not aware of any such rule that states that dependent claims must begin with "the" instead of "a." In fact, a preliminary search of the U.S. PTO Website has revealed at least several thousand patents that include dependent claims that start with "a." Thus, withdrawal of the objection is respectfully requested.

Rejections under 35 U.S.C. §112, ¶2

Claim 54 was rejected under 35 U.S.C. 35 U.S.C. §112, ¶2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Office Action asserts that the step of "replacing the masking system" requires a maskant.

At the outset, Applicants note that claim 54 (and independent claim 53, from which it depends) does not recite "replacing" as stated in the Office Action, but rather, recites "re-placing." The term "re-placing" is defined in the specification, for example, on page 12, lines 2-3 and, according to the definition in the specification, re-placing the mask of claim 54 can result in some or all of the first portion of the surface being free of shielding from the mask and open to the application of the agent thereto. For example, the mask could be completely removed from the article surface, according to the claimed invention.

It is not clear to the Applicants why the Office Action states that a "maskant" is required. Claim 54 recites a "mask" and claim 53 recites a "masking system." Clarification or withdrawal of the rejection of claim 54 is therefore respectfully requested.

Rejections under 35 U.S.C. §103(a) with respect to Hembree

Claims 1-33, 36, 38, 41, 42, 45, 50-52, and 64-66 were rejected under 35 U.S.C. 35 U.S.C. §103(a) as being unpatentable over Hembree, et al., U.S. Patent No. 6,181,144 ("Hembree").

The Office Action states that the elastomeric mask of Hembree must inherently be cohesive " in order for the openings to be formed therein." However, "cohesive" as used in the instant application does not refer to a material that is a solid (i.e., able to obtain an opening formed therein), but rather, "cohesive" refers to attractive forces within the mask that are able to hold the mask together and are stronger than the forces that are required to remove the mask from a surface (see e.g., page 12, lines 8-9 of the present specification).

Regarding claim 51, Hembree discusses the degradation of that portion of his mask proximate the portion of his article which he wishes to be unshielded. See, e.g., col. 10, lines 22-24. Claim 51 is therefore believed to be patentable in view of Hembree, and withdrawal of the rejection of claim 51, and the claims that depend therefrom, is respectfully requested.

Regarding claim 52, Hembree nowhere discusses curved surfaces, as recited in claim 52, as that term would be understood to those of ordinary skill in the art based upon the instant specification. Thus, claim 52 is believed to be patentable in view of Hembree, and withdrawal of the rejection of claim 52, and the claims that depend therefrom, is respectfully requested.

Claims 1-33, 36, 38, 41, 42, 45, and 64-66 have been canceled. Accordingly, it is believed that the rejection of these claims is moot.

Rejection under 35 U.S.C. §103(a) with respect to Parsons

Claims 53-62 were rejected under 35 U.S.C. §103(a) as being unpatentable over Parsons, U.S. Patent No. 4, 093,754 ("Parsons") for the reasons stated in the Office Action.

Parsons nowhere suggests or discloses a channel having a dimension of less than 1 millimeter, as recited in claim 53, as amended. Parsons is directed towards "making large glass or plastic panels having the appearance of etched glass panels," for example, for a window (Abstract; column 1, lines 6-9). It appears that the patterns of Parsons are all the result of masking sections at relatively large dimensions for sandblasting. Thus, it is not seen where Parsons would suggest or motivate a channel having a dimension of less than 1 millimeter. Accordingly, withdrawal of the rejection of claim 53 is respectfully requested. Claims 54-62 depend, either directly or indirectly, from claim 53, and are believed to be patentable for at least these reasons. Thus, the rejection as applied to the dependent claims will not be discussed in

detail, although the Applicants do not concede the accuracy of the points discussed in the Office Action. The withdrawal of the rejection of claims 54-62 is also therefore respectfully requested.

Rejection under 35 U.S.C. §103(a) with respect to Gordon

Claims 83 and 87-90 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon, et al., U.S. Patent No. 5,486,452 ("Gordon").

As claims 83 and 87-90 have been canceled, it is believed that this rejection is moot.

Rejection under 35 U.S.C. §103(a) with respect to Gordon in view of Wohlstadter

Claims 84-86 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon in view of Wohlstadter, *et al.*, U.S. Pat. No. 6,207,369 ("Wohlstadter").

As claims 84-86 have been canceled, it is believed that this rejection is moot.

CONCLUSION

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If, for any reason, the Examiner is of the opinion that a telephone conversation with the Applicants' representative would expedite prosecution, the Examiner is kindly invited to contact the undersigned at (617) 573-7851.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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